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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/527,702

03/11/2005

Samir Zard

004900-271

5275

21839 7590 04/18/2007  
BUCHANAN, INGERSOLL & ROONEY PC  
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EXAMINER

NWAONICHA, CHUKWUMA O

ART UNIT

PAPER NUMBER

1621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/527,702	ZARD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Chukwuma O. Nwaonicha	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 20-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 14-16 and 19 is/are rejected.
- 7) ☒ Claim(s) 9, 11-13, 17 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Current Status***

1. Claims 1-42 are pending in the application.

### ***Election/Restrictions***

Applicant's election with traverse of Group I in the reply filed on 2/20/07 is acknowledged. Applicants' traversal of restriction requirement is not persuasive because the inventions listed as Groups 1-12 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group 1 is drawn to process for making the compounds, Groups 2-5 and 7-10 are drawn to processes for making different compounds, while Groups 6 and 12 are drawn to different compounds and processes of making them. Group 11 is drawn to compounds of different functionalities. These twelve groups of invention are different from each other. Therefore, there is no special technical feature for the compounds, the processes of making these compounds or the different fields of application of the compounds. Also there is no unity of invention. Groups 1-12 require different search strategies that will impose an undue burden on the Examiner.

The requirement is still deemed proper and is therefore made **FINAL**.

Groups 2-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups, there being no allowable generic or linking claim. All claims consisting of Group 1 will be examined on the merits.

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Applicants are reminded of their right to file divisional applications to the non-elected claims.

Applicants' are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Priority***

Applicants' claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 5, 6 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3, 5 and 6 are indefinite because they depend on two claims. Correction is required.

Claim 19 is indefinite because it is not clear what reagents are reacting. Correction is required.

***Claim Rejections - 35 USC § 102***

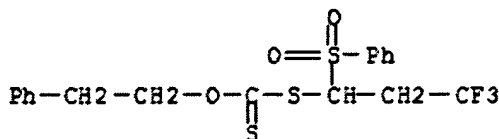
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7, 8, 14 and 15 are rejected under 35 U.S.C. 102(a) as being anticipated by Bertrand et al., {A Xanthate Transfer Radical Process for the Introduction of the Trifluoromethyl Group, *Org. Lett.*; (Letter); 2001; 3(7); 1069-1071}.

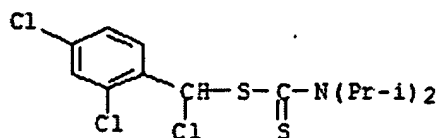
Bertrand et al. disclose applicants claimed compound as shown below. See Abstract.



Claims 1, 2, 6, 7, 8 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated Hilton et al., {Phytotoxicity of herbicides as measured by root absorption, *Weed Research* (1964), 4(3), 216-22}.

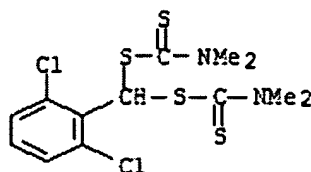
Hilton et al. disclose applicants claimed compound as shown below. See Abstract.

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Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated  
Gradsten et al., {US 3,266,882}.

Gradsten et al. disclose applicants claimed compound as shown below. See  
Abstract.



### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

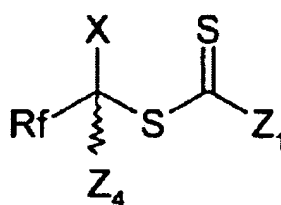
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 7, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gradsten et al., {US 3,266,882}.

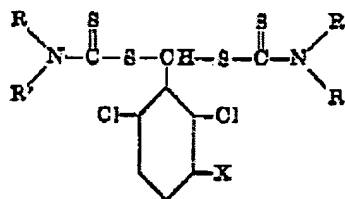
Applicants claim a compound of formula 1; wherein all the variables are as defined in the claims.



formula 1

**Determination of the scope and content of the prior art (M.P.E.P. §2141.01)**

Gradsten et al. teach a compound of the general formula 2; wherein R, R' are alkyl group having from 1 to 4 carbon atoms and X is hydrogen or chlorine. See columns 3 and 4.



formula 2

**Ascertainment of the difference between the prior art and the claims (M.P.E.P. §2141.02)**

Gradsten et al. compound differs from the instantly claimed compound in that Gradsten et al. compound of formula 1 is a subgenus of the instantly claimed

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compound. Specifically, applicants claim a compound wherein the variable Z1 is  $\text{NR}^i\text{R}^j$  ( $\text{R}^i$  and  $\text{R}^j$  are alkyl),  $\text{R}_f$  is halogenated aryl and  $\text{Z}_4$  is hydrogen, which is taught in the prior art of Gradsten et al.

**Finding of prima facie obviousness--rational and motivation (M.P.E.P.. §2142-2143)**

The instantly claimed compound would have been suggested to one of ordinary skill because one of ordinary skill wishing to obtain the compound is taught to select the compound from the genus of Gradsten et al.

One of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention by varying the variables ( $\text{R}_f$ ,  $\text{Z}_4$ , X, and Z1) to arrive at the instantly claimed compound. Said person would have been motivated to practice the teaching of the references cited because it demonstrates that the compound is a useful herbicidal compound. The instantly claimed invention would therefore have been obvious to one of ordinary skill in the art.

***Allowable Subject Matter***

Claim 4 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Allowable Subject Matter***

Claims 9, 11-13, 17 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



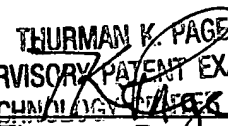
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman k. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit: 1621

  
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